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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,592	03/06/2001	Robert Olan Keith JR.	ABREAU-00103	2681

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EXAMINER

NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 03/01/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,592

Applicant(s)

KEITH, ROBERT OLAN

Examiner

CamLinh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. Claims 1 - 37 of this application conflict with claims 1 - 49 of Application No. 09/801,072, and with claims 1 – 96 of Application No. 09/801,138. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1 – 37 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 - 49 of copending Application No. 09/801,072, and with claims 1 – 96 of copending Application No. 09/801,138. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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The following table shows the claims in '592 that are rejected by corresponding claims in '072 and '138.

Claims comparison table

'592	'072	'138
Claims		
1-2, 11-12, 20-21, 30 –31, 37	1, 10-11	1-2,11-12
3, 13, 22, 32	2	4
4, 14, 23, 33	3	5
5, 15, 24, 34	4	6
6, 16, 25, 35	5	3
7, 17, 26, 36	6	7
8, 18, 27	7	8
9, 19, 28, 36	8	9
10, 29	9	10

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Witek et al (U.S. 6,253,188).

♦ As per claim 1, 11, 20, 30, 37

Witek discloses a method of performing a research task within a searchable database comprising:

- "Performing a search by utilizing a search module, the search module includes a keyword search, hierarchical search, a dichotomous key search, and a parametric search ... matching items" See Fig. 1, 7,10. In particular:
 - o "A search module" corresponds to the search engine that implemented in Fig. 1.
 - o "A search criteria" corresponds to arguments or selections that user enters in Fig. 7, element 112.
 - o "A searchable database" corresponds to database server (Fig. 1, element 20, col. 9, lines 53 – 55)
 - o "One or more matching items" corresponds to the results that sent to user (Fig. 7, element 126 – 128).
 - o "The search module includes keyword search" See Fig. 10, element 148, col. 29, lines 28 – 34.
 - o "A hierarchical search" corresponds to "category search" because the categories include subcategories that organized in a hierarchical order. See Fig. 4, col. 31, lines 4 – 11.

- “A dichotomous key search” See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10, element 144 – 146. As defined in the Specification a “dichotomous key search” is used to instruct users given in an answer or question dialog, often yes or no answer (Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the “dichotomous key search”.
 - “A parametric search” See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29.
 - “The searchable database is formatted in a directory tree structure” See Fig. 4, col. 18, lines 1 – 32.
 - “The directory tree structure includes nodes ... branches” See fig. 4. Each category corresponds to a node. All nodes are linked together.
 - “Selecting one of the matching item” See Fig. 6, element 106 – 110, col. 23, lines 44 – 48.
 - “Formatting the collection of related data corresponding to the node of the selected matching item into an encyclopedia-like entry” See Fig. 4, col. 18, lines 1 – 32.
 - “Displaying the encyclopedia-like entry corresponding to the node of the selected matching item” see Fig. 7, element 128- 130.
- ◆ As per claim 2, 12, 21, 31,

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- "The encyclopedia-like entry includes text, graphics, links..." See Fig. 8 – 10, col. 23, lines 44 – 48, col. 24, lines 10 – 16.
- ♦ As per claim 3, 13, 22, 32, Witek discloses:
 - "The search criteria is one or more keywords input by a user" See Fig. 10, element 148, col. 29, lines 28 – 34.
- ♦ As per claim 4, 14, 23, 33, Witek discloses:
 - "The utilized search methodology is the hierarchical search, the search criteria is selected one of a list of one or more directory items" A hierarchical search" corresponds to "category search" because the categories include subcategories that organized in a hierarchical order. See Fig. 4, 6 – 7, col. 31, lines 4 – 11.
- ♦ As per claim 5 – 6, 15 – 16, 24 – 25, 34 – 35
 - "The utilized search methodology is the dichotomous key, the search criteria is a selected one of two binary items" See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10, element 144 – 146. As defined in the Specification a "dichotomous key search" is used to instruct users given in an answer or question dialog, often yes or no answer (Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the "dichotomous key search".
 - "The utilized search methodology is the parametric search, the search criteria is one or more set parameters, and further wherein the parameters are set by a user" See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29. As shown

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in Fig. 10, a user can set the values for parameters such as date, the range price, or number of room.

♦ As per claim 7, 17, 26, 36, Witek discloses:

- "The searchable database is distributed into more than one physical location"

See Fig. 1, element 20, col. 9, lines 53 – col. 10, lines 5, col. 25, lines 37 – 44.

♦ As per claim 8 - 10, 18 - 19, 27 – 29, Witek discloses:

- " The steps of performing a search and formatting the collection of related data are performed by a server" See Fig. 1, 5A, col. 25, lines 13 – 33.
- " Establishing an Internet connection with the server to utilize the search methodologies" See Fig. 5a, element 14, 24, col. 21, lines 15 – 20.

Response to Arguments

3. Applicant's arguments with respect to claims 1 - 37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Monberg et al (U.S. 6,523,021) discloses a business directory search engine.
- Vanderpool et al (U.S. 5,781,773) discloses a method for transforming and storing data for search and display and a searching system utilized therewith.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is 305-1951.

The examiner can normally be reached on Monday-Friday.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cam-Linh Nguyen
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LN


WAYNE AMSBURY
PRIMARY PATENT EXAMINER